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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 85919183 |
| Applicant | Cooperative Educational Service Agency N |
| Applied for Mark | CURRICULUM4SCHOOLS |
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| Submission | Appeal Brief |
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| Date | 11/17/2014 |

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| In re Application of |) | |
| Cooperative Educational Service Agency No. 6 |) | Law Office 102 |
| |) | |
| |) | Trademark Attorney: |
| Serial No. 85/919,183 |) | |
| |) | Dominic J. Ferraiuolo, Esq. |
| Filed: April 30, 2013 |) | |
| |) | |
| Trademark: CURRICULUM4SCHOOLS |) | |
| |) | |

for “Computer software that provides web-based access to applications and services through a web operating system or portal interface” in Int’l Class 9 (“Applicant’s Mark”).

The Rejection

The Examining Attorney refused registration of Applicant's Mark contending that the mark as applied to the goods is "merely descriptive." Office Actions dated August 7, 2013 and February 28, 2014, the latter being a final Office Action. In response to Request for Reconsideration filed with the Examining Attorney, that Request was denied on September 18, 2014.

In the Denial of Applicant's Request for Reconsideration, the Examining Attorney expounded his position contending the following:

The specimen of record shows use of the mark on a series of web pages explaining the goods that state "CURRICULUM4SCHOOLS" Teachers and administrators can access and enhance curriculum content from any location. The specimens of record show that the goods are used for schools curriculum mapping and management. The registrations applicant cites in support of its request only show the numeral "4" used to replace the wording "for" as a phonetic equivalent in marks that as a whole are not merely descriptive due to suggestive or non-descriptive meaning as a whole. Here, the numeral "4" is the phonetic equivalent of the wording "for" and identifies that a purpose, feature or function use of the goods is curriculum software for schools to use. Therefore, the applied-for mark is not similar to the marks cited by applicant in support of registration but rather, viewed as a whole, merely descriptive of the goods (emphasis added).

Applicant respectfully traverses the notion that a "curriculum" is limited to digital media or a software rendition of a curriculum. A "curriculum" can evoke a wide variety of notions including the aggregate of courses of study given in a school, college, university, etc. Indeed, the word "curriculum" is a rather amorphous term having an almost limitless number of meanings in its own right. The fact that the Examining Attorney had to resort to reference to the Applicant's specimens to derive a specific meaning is a tacit admission that even the Examining Attorney was not quite sure what the goods meant in view of the name given to the software which is the subject of the mark.

Further, even if a "curriculum" is considered in a digital realm only, it is not immediately apparent if the "curriculum" is a tool for educational institutions, administrators,

educators, students or some combination of them. Further, it is not immediately apparent if the “curriculum” is used at a given level of education – grade school, high school, technical college, graduate school or post-graduate school. Lastly, it is not immediately apparent what course or courses of study are the subject of the “curriculum,” what the “curriculum” might relate to or what the objective of the curriculum is. In other words, the who, what and why of the curriculum is not evident from the identifier, thus dictating a finding of “suggestiveness” of the mark – and not a finding that the mark is “merely descriptive.”

Argument

1. Applicant’s Mark Is A Composite Mark That Must Be Considered In Its Entirety

Applicant respectfully submits that the CURRICULUM4SCHOOLS mark is a “composite” mark. Accordingly, the Examining Attorney cannot depart from the rule that marks should be considered in their entirety and not improperly dissected. *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 U.S.P.Q. 272 (C.C.P.A. 1970). As the U.S. Supreme Court has stated: “The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.” *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920). Thus, it is the impression which the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof which is important.

Applicant respectfully submits that Applicant’s Mark has been improperly dissected to arrive at the conclusion of mere descriptiveness.

2. The Applicant’s Mark, in its Entirety, does not Merely Describe Applicant’s Goods

To be “merely” descriptive, the term must be “only” descriptive, i.e., the term serves no purpose other than to describe the goods or services. *In re Quick-Print Copy Shop, Inc.*, 205 U.S.P.Q. 505 (C.C.P.A. 1980). If a mark suggests, however, a number of possible uses or characteristics of the goods or services, including one that is descriptive, the mark is not merely

descriptive. *In re National Tea Co.*, 144 U.S.P.Q. 286, 287 (T.T.A.B. 1965) (NO BONES ABOUT IT not merely descriptive of ham).

There is but a thin line between the two types of marks (descriptive versus suggestive); where there is doubt whether a mark is descriptive or suggestive, that doubt should be resolved in favor of the applicant. *In re Bel Paese Sales Co.*, 1 U.S.P.Q.2d 1233, 1986 WL 83304 (T.T.A.B. 1986).

Applicant's Mark is, at best, suggestive of Applicant's goods. The Applicant's mark does not convey an immediate impression of the goods. "CURRICULUM," "4" and "SCHOOLS" are terms of art in the English language. Whether or not they have precise connotations, together they do not immediately describe with particularity the goods (again, we are speaking of computer software programs), and the terms are therefore suggestive, as in cases such as *Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 U.S.P.Q.2d 1054, n3 (TTAB 1989) ("technology" is a vague term which does not immediately describe computer products); *U.S. West Inc. v. BellSouth Corp.*, 18 U.S.P.Q.2d 1307, 1312 (TTAB 1990) ("real" is a vague term which does not immediately describe telephone directories); see also *In re Intelligent Medical Systems Inc.*, 5 U.S.P.Q.2d 1674, 1675-1676 (TTAB 1987) ("intelligent" is a vague term which does not immediately describe electronic thermometers); and *In re Men's International Professional Tennis Council*, 1 U.S.P.Q.2d 1917 (TTAB 1986) ("masters" is a general term which does not immediately describe tennis tournament services).

In the present case, the meaning of the terms "CURRICULUM" and "SCHOOLS" are general enough that an ordinary consumer would not generate the immediate and direct idea of the nature of the goods which is necessary to cast the mark as merely descriptive. Descriptiveness must be adjudged from the standpoint of the ordinary prospective purchaser, see TMEP 1209.01(b) and *In re Gyulay*, 3 U.S.P.Q.2d 1009, 1010 (Fed.Cir.1987). At best, the mark

may convey some sort of connection to a school-related user, but there is nothing in the mark which describes Applicant's goods, namely, computer software. An ordinary consumer simply could not imply that the goods are computer software merely by looking at the mark and, more importantly, knowing that the goods are computer software, the same consumer would not know the purpose to which the software is put, who would use it, who would benefit by its use, what curriculum it encompasses, what grade levels it may apply to and why someone would use it and to what result or benefit. In short, the mark is still suggestive because the goods, i.e., computer software, are still unknown to the person seeing only the mark. Once knowing that the mark has something to do with software, there are still too many questions that must be answered in order to determine that the mark is merely descriptive of the goods with which the mark is used. That is, the impression given by the mark requires the exercise of some imagination on the part of a person perceiving the mark. Thus, because some imagination is required, the mark is not "merely descriptive."

Even if a mark suggests a number of possible uses or characteristics of the goods or services, including one that is descriptive, the mark is not merely descriptive. *In re National Tea Co.*, 144 U.S.P.Q. 286, 287 (T.T.A.B. 1965) (NO BONES ABOUT IT not merely descriptive of ham). Further, a mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (holding SUGAR & SPICE not to be merely descriptive of bakery products). Applicant submits that the mark CURRICULUM4SCHOOLS does not convey an immediate or instant idea as to the nature of Applicant's goods, namely, computer software. Although the mark CURRICULUM4SCHOOLS may connote a school-type connection, this does not suggest only computer software or computer software that is drawn to a target consumer or user, the type of curriculum that is used, and to what benefit or purpose the

curriculum would be. One must make a quantum leap from software to software for a specific purpose, i.e. one that is tied to a curriculum, whatever that curriculum may be – and what it may be is left to the imagination of the consumer.

Because the mark CURRICULUM4SCHOOLS does not convey an immediate idea of the identified goods, and instead, requires a mental pause and thought, Applicant submits that the term is suggestive rather than merely descriptive of the goods. A suggestive term requires some imagination. A suggestive term requires some “imagination, thought or perception to reach a conclusion as to the nature of the goods.” TMEP §1209.01(a); *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983). If a term provides indirect or vague information about a product, this is an indication that the term is suggestive, not descriptive. *See Blisscraft of Hollywood v. United Plastics Co.*, 131 U.S.P.Q. 55 (2d Cir. 1961); see also *AMF, Inc. v. Sleekcraft Boats*, 204 U.S.P.Q. 808, 815 (9th Cir. 1979); See *In re Broco*, 225 U.S.P.Q. 227 (T.T.A.B. 1984) (reversing a refusal to register THE LIBRARY COMPANY for library supply services); *In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57 (T.T.A.B. 1978) (reversing a refusal to register THE MONEY SERVICE for financial services, finding the mark suggestive and not merely descriptive); and *In re The House Store, Ltd.*, 221 U.S.P.Q. 92 (T.T.A.B. 1983) (reversing a refusal to register THE HOUSE STORE for retail services of furniture and housewares, finding the mark suggestive rather than merely descriptive).

Applicant’s Mark is, at most, suggestive of Applicant’s goods. While it may be considered that the word “SCHOOLS” conveys one characteristic of the goods, the number “4” placed immediately in front of the word “SCHOOLS” makes the composite element “4SCHOOLS” distinctive.

There are any number of “4-something” marks that have not been deemed descriptive, including many in Int’l Class 9, which is the same class in which the Applicant’s

CURRICULUM4SCHOOLS mark is applied for. Applicant's mark should not be treated differently than currently existing registrations. Applicant supplied such list in its February 7, 2014 Response to Office Action.

3. Applicant Incorporates Its Prior Arguments Herein By Reference

Applicant has presented arguments in response to the two prior Office Actions issued by the Examining Attorney. Applicant affirmatively states that it incorporates its prior arguments in this Brief by reference for purpose of brevity.

Conclusion

For the reasons set forth above, Applicant respectfully submits that its mark, CURRICULUM4SCHOOLS, is not merely descriptive, but suggestive, and is entitled to registration.

The Board is therefore respectfully requested to reverse the Examining Attorney's decision refusing registration of Applicant's Mark.

Respectfully submitted,
Cooperative Educational Service Agency No. 6
By Its Attorneys

Dated: November 17, 2014

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